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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,469	06/25/2003	Philip M. Sadler	55138-CON(71331)	3506
21874	7590	08/05/2004	EXAMINER	
EDWARDS & ANGELL, LLP			NGUYEN, THONG Q	
P.O. BOX 55874			ART UNIT	
BOSTON, MA 02205			PAPER NUMBER	
			2872	

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No. 10/606,469	Applicant(s) SADLER, PHILIP M.	
	Examiner Thong Q Nguyen	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 11-14 and 21-23 is/are rejected.
- 7) ☒ Claim(s) 3, 7-10 and 15-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the amendment filed on 7/19/2004. It is noted that in the mentioned amendment, applicant has made amendments to the specification and the claims as follow.

A) Regarding to the amendments to the specification, it is noted that all amendments to the specification are approved by the Examiner. Regarding to the substitute specification filed on 7/19/2004, such a substitute specification has not been entered because it failed to comply with the requirement as set forth in 37 CFR 1.125(b) which requires that the applicant has filed a statement that the new/substitute specification does not contain any new matter. Applicant should note that the statement that the amendments do not contain new any matter as provided in the amendment in page 13, the second paragraph is not considered as a statement for the same in regard to the filing of the new substitute specification.

B) Regarding to the claims, it is noted that applicant has made amendments to claims 1, 3, 8, 13 and 14 and simultaneously added a new set of claims, i.e., claims 21-23, into the present application. A review of the device claimed in the newly-added claims 21-23 has resulted that the device of new claims has the same scope as that recited in the original claims 1-16, and thus, all pending claims 1-16 and 21-23 are examined in this Office action.

Drawings

2. The amendments to the specification and applicant's arguments regarding to the objections to the drawings as provided in the amendment of 7/19/2004 are sufficient to overcome the objections to the drawings, and thus the drawings are now accepted by the Examiner.

Specification

3. The lengthy specification which is amended by the amendment has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 22 is indefinite because the features relating to the center of the primary and the center of the first mirror (or prism) as recited in last two lines of the claim lack proper antecedent basis. Applicant should note that such a rejection to the claim is made to claim 13 as original filed. While applicant has amended claim 13 to overcome the rejection; however, the new claim 22 is drafted in an identical to

the original claim 13 and applicant has not made any amendment to the claim 22 to make the claim comply with the rule.

b) Claim 23 is indefinite because it is unclear about the bound and metes defined by the recitation thereof "other straight reference object...of light" (claim 14, lines 2-3). Applicant should note that such a rejection to the claim is made to claim 14 as original filed. While applicant has amended claim 14 to overcome the rejection; however, the new claim 23 is drafted in an identical to the original claim 14 and applicant has not made any amendment to the claim 23 to make the claim comply with the rule.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-2, 4-6, 11-14 and 21-23, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over James (U.S. Patent No. 3,603,664, submitted by applicant) in view of Braymer (U.S. Patent No. 2,753,760) (all of record).

James discloses a telescope system having a telescope rotatably mounted on a mounting system. The telescope system as described in columns 3-4 and shown in figures 1-2 comprises the following features: First, a telescope assembly having optics including at least two light folding elements (24, 25, 26), an eyepiece or camera (28) disposed near the focus (F) of the system, a projecting surface located around the position of the eyepiece or camera; Second, a telescope frame (14) of a spherical configuration for supporting the optics of the

telescope assembly; and Third, a mounting system (12) having a curved supporting surface for rotatably supporting the telescope frame wherein the center of curvature of the curved surface © does not change during the process of rotation the telescope frame. It is noted that the mounting system (12) has a diameter which is matched or larger than the diameter of the telescope frame (14). It is also noted that each of the light folding elements is in the form of a mirror, and the range of the rotating angle cover a range of 0 degree to 90 degrees as claimed in present claim 5. The use of bearing elements (30) and ring (40) will stabilize the telescope frame at any specified elevation.

There are two things missing from the telescope system provided by James are as follow: First, he does not explicitly state the use of an objective lens in the telescope assembly, and Second, he does not disclose the use of a pointing system with the telescope. However, a telescope system having a lens located in the object side of the telescope which also comprises a pointing system is known to one skilled in the art as can be seen in the telescope system provided by Braymer. In his telescope system described in columns 2-3 and shown in figures 1-2, Braymer discloses the use of a lens element (7) at the object side of the telescope system and a pointing system having objective lens (19') which is in combination with a prism (18) provides a visual guide having an optical axis parallel to the axis of the light incident onto the first mirror (5,6). Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the telescope system having a telescope frame supporting optics and a

mounting system as provided by James by using a telescope assembly having a lens in the object side as suggested by Braymer for the purpose of correcting the image aberrations and a pointing system integrally to the telescope frame supporting the optics as suggested by Braymer for the purpose of providing a means for finding the object before an observation.

Allowable Subject Matter

8. Claims 3, 7-10 and 15-16 are objected to as being dependent upon a rejected base claim, but would be allowable if each of claims 3, 7, 8, 15 and 16 is rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Regarding to the rejection of claims 1-2, 4-6, 11 and 13-14, now applied to claims 1-2, 4-6, 11-14 and 21-23, applicant's arguments filed on 7/19/2004 have been fully considered but they are not persuasive for the following reasons.

A) Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

B) In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

C) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., solar or sun rays, etc...) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

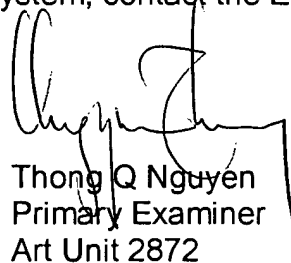
D) In response to applicant's argument that the device claimed is used for safely observing the sun, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, all of the features appeared after the term "comprising" do not provide any structural limitations for the so-called "safely observing the sun" as recited in the preamble of the claim.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q Nguyen
Primary Examiner
Art Unit 2872
